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3M INNOVATIVE PROPERTIES COMPANY PO BOX 33427 ST. PAUL, MN 55133-3427			ROSSI, JESSICA	
			ART UNIT	PAPER NUMBER
			1733	

DATE MAILED: 02/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/016,541

Applicant(s)

MITRA ET AL.

Examiner

Jessica L. Rossi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) 19-37 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 December 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---------------------------------------------------------------------------------------------------------------------------------------------------------------------|----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>3/12/02, 4/12/02, 3/4/03, 6/9/03</u> | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-18, drawn to a method for temporary surface protection or surface modification, classified in class 156, subclass 229.
 - II. Claims 19-33, drawn to a method for temporary surface protection or modification in a hospital or dental office, classified in class 156, subclass 290.
 - III. Claims 34-37, drawn to a bib, classified in class 428, subclass 343.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are distinct method combinations. Each group relies on different elements for patentability not required by the other. Group I requires a sheet material having been non-elastically stretched in at least one dimension by a stretch ratio of at least 1:1.05, an activatable adhering side comprising a plurality of surface elements separated from each other leaving openings between adjacent surface elements, wherein this separation is caused by stretching the sheet material, and an adhesive layer at least partially exposed through the openings between surface elements, whereas Group II does not. Group II requires temporary surface protection in a hospital or dental office, applying the sheet on a target surface found in a hospital or dental office, and the utility side of the sheet providing a desired surface contact property not available on the contact surface, whereas Group I does not.
3. Inventions I and III are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be

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made by another and materially different process (MPEP § 806.05(f)). In the instant case, the bib could be made by another and materially different process where the bib is made without stretching a sheet material and/or the adhesive side of the bib does not comprise a plurality of surface elements.

4. Inventions II and III are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case, the bib can be made by another process wherein the bib is not formed by a multi-layer sheet material.

5. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

6. During a telephone conversation with Ms. Doreen Gwin on 8/6/03 a provisional election was made with traverse to prosecute the invention of Group I, claims 1-18. Affirmation of this election must be made by applicant in replying to this Office action. Claims 19-37 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

7. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the

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application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1-16 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Calhoun et al. (US 5240761; provided in IDS) in view of the collective teachings of Ochi (US 4556595; provided in IDS), Merrill et al. (US 3857731; provided in IDS), Gochanour (US 5774889), and Hibler (US 6493879).

With respect to claim 1, Calhoun is directed to a method for making a sheet material having a pressure-sensitive adhesive backing and attaching the sheet material to a target surface (column 2, line 66 – column 3, line 6; column 3, line 62-63). The reference teaches making a variety of sheet materials having a variety of uses (i.e. electrically conductive tape, abrasive sheet, or **repositionable adhesive-backed sheet**; column 9, lines 3-21); however, despite its intended use, each sheet is made using the same method steps (column 9, lines 3-21), as set forth below.

The reference teaches providing a sheet material having an activatable adhering side and an opposing utility side, wherein the sheet material has a base portion having physical characteristics of having been non-elastically stretched in at least one dimension by a stretch ratio of at least 1:1.05 (note p. 15, lines 11-14 of Applicant's specification, which defines ratio,

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then note example 1, column 6 lines 39-43, of reference where original length is 10 cm and final length is 17.5 cm resulting in stretch ratio of 1:1.75).

The reference teaches the activatable adhering side comprising a plurality of surface elements (i.e. glass beads) separated from each other leaving openings between adjacent elements, wherein separation of the elements is caused by stretching of the sheet material (Figures 1-2; column 3, lines 4-6). The examiner would like to point out that the sheet material can be a polyester or an elastomer, wherein the polyester can maintain its stretched dimensions such that transfer of the separated particles to another adhesive-backed sheet, which serves as the final product, is unnecessary (column 2, line 66 – column 3, line 6; **column 4, lines 7-10**).

The reference teaches the sheet material having an adhesive layer at least partially exposed to the activatable adhering side through the openings between surface elements (column 3, lines 26-32) such that after activation by the user (column 5, lines 13-14), the activatable adhering side exhibits an adhesive peel force greater than an adhesion peel force exhibited prior to activation by the user (column 9, lines 11-15).

The reference teaches applying the activatable adhering side of the sheet material on a target surface and activating the activatable adhering side (column 9, lines 11-19).

The reference is silent as to the sheet material being used for temporary protection or modification of the target surface.

It is known in the art to temporarily modify a target surface by attaching a repositionable pressure-sensitive adhesive-backed sheet material to the target surface, wherein the adhesive has a plurality of elements projecting from its exposed surface such that the elements first contact the target surface thereby allowing the sheet material to be correctly positioned before activation of

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the same, as taught by Ochi (Figure 1a; column 1, lines 7-8 and 13-17 and 44-46; column 6, lines 21-26; column 6, lines 27-31; column 7, lines 42-45; column 8, lines 43-45) and Merrill (Figure 1; column 1, lines 9-11; column 3, lines 30-31; column 5, lines 7-13). It is also known in the art to temporarily protect or modify a target surface by attaching a pressure-sensitive adhesive-backed sheet material to the target surface, as taught by Gochanour (abstract; Figure 1; column 3, lines 40-41) and Hibler (Figure 3; abstract; column 4, lines 38-41).

One reading the Calhoun reference as a whole would have appreciated that the sheet material can be used for a variety of purposes (column 9, lines 3-15) and therefore the skilled artisan would have been motivated to temporarily protect or modify the target surface of Calhoun (column 9, lines 11-15) by providing the sheet material of Calhoun with a utility side having the necessary characteristics because such is known in the art, as taught by the collective teachings of Ochi, Merrill, Gochanour, and Hibler, wherein this allows for protection and/or modification of a surface without having to manipulate the surface itself.

Regarding claim 2, Calhoun teaches activating the adhering side by applying hand pressure (column 5, lines 13-14).

Regarding claim 3, Calhoun teaches the sheet material being repositionable after being applied to the target surface (column 9, lines 11-15) but is silent as to it being easily removable after being activated. However, the skilled artisan would have appreciated that the repositionable adhesive-backed sheet material of Calhoun would be easily removable after being activated (note similarities between sheet material of Calhoun and present invention; also note similarities between sheet material of Calhoun and Merrill, who teaches sheet material being easily removable at column 1, lines 9-11 and column 5, lines 6-13).

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Regarding claim 4, Gochanour teaches at least a portion of the sheet material being impermeable to fluids through the utility side (column 4, lines 6 and 12-13).

Regarding claim 5, Hibler teaches at least a portion of the sheet material being impermeable to fluids through the utility side (column 4, lines 4-8).

Regarding claim 6, Calhoun teaches the sheet material being highly flexible such that it easily conforms to the target surface (column 4, lines 55-54 and 63-66).

Regarding claim 7, Gochanour teaches the utility side of the sheet material having a higher coefficient of friction than the target surface (column 4, lines 46-49) when contacting an object such as a tool or human skin (column 1, lines 10-11 and 60; column 2, lines 65-67).

Regarding claim 8, Gochanour teaches the utility side of the sheet material can be transparent (column 4, lines 38-39); therefore, since the target surface is a human hand (column 1, lines 5-8), the skilled artisan would have appreciated that the utility side would have an optical characteristic different from the target surface.

Regarding claim 9, Calhoun teaches providing the sheet material in roll form (column 4, lines 55-58).

Regarding claim 10, it would have been obvious to provide the sheet material of Calhoun in pre-cut sheet form as an alternative to roll form because such is known in the art, as taught by Gochanour (column 6, lines 18-19 and 23-25) and Hibler (column 2, lines 55-58), wherein this allows for stacking of the sheets.

Regarding claim 11, Gochanour teaches the sheet material being aseptic for providing infection protection (column 7, lines 42-44).

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Regarding claim 12, Gochanour teaches the utility side of the sheet material bearing an antibacterial agent (column 4, lines 43-45).

Regarding claims 13-14, Gochanour teaches the sheet material being transparent to visible light (column 4, lines 38-39); note transparent and translucent are synonyms.

Regarding claims 15-16, Ochi teaches the sheet material can be partially impermeable to light of wavelengths in a specific range while also teaching the sheet material being opaque to visible light since the reference teaches the sheet being any color (column 6, lines 21-26).

Regarding claim 18, Ochi teaches the utility side of the sheet material bearing printed indicia (column 6, lines 24-26).

10. Claims 15-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Calhoun et al. and the collective teachings of Ochi, Merrill et al., Gochanour, and Hibler as applied to claim 1 above, and further in view of Kaltman et al. (US 5711026).

Regarding claim 17, Calhoun is silent as to the sheet material being adapted to provide radiation protection. It would have been obvious to the skilled artisan to have the sheet material of Calhoun be adapted to provide radiation protection because such a pressure-sensitive adhesive-backed sheet material is known in the art, as taught by Kaltman (abstract; column 1, lines 19-27), wherein this imparts a characteristic to the sheet material that makes it very attractive to consumers.

Regarding claims 15-16, the skilled artisan would have appreciated that the sheet material of Kaltman is at least partially impermeable to light of wavelengths in a specific range while also being opaque to visible light.

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11. Claims 1-4 and 6-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gochanour in view of Calhoun et al.

With respect to claim 1, Gochanour teaches a method for temporarily protecting or modifying a surface (abstract). The reference teaches providing a sheet material having a base portion 12 (column 5, lines 1-2), a pressure-sensitive adhesive 20 on the backside of the base portion, and a utility side on the front side of the base portion (Figure 1; column 3, lines 39-42; column 6, lines 60-62). The reference teaches applying the adhering side to a target surface and activating the adhering side (Figure 2).

The reference is silent as to non-elastically stretching the base portion, the adhering side of the sheet comprising surface elements, and the adhesive layer exposed through the surface elements such that after activation by a user, the adhering side exhibits an adhesion peel force greater than that exhibited before activation.

Applicants are directed to paragraph 9 above for a complete discussion of Calhoun. It would have been obvious to the skilled artisan at the time the invention was made to provide the exposed surface of the pressure-sensitive adhesive of Gochanour with a plurality of surface elements, whereby non-elastically stretching the base portion of the sheet material in at least one dimension by a ratio of at least 1:1.05 results in separation of the surface elements located on the surface of the adhesive because such is known in the art, as taught by Calhoun, and this allows the sheet material to be correctly positioned on the target surface before activating the adhesive to bond the sheet material to the same (Calhoun; column 9, lines 11-15). The skilled artisan would have appreciated that the sheet material is repositionable because its peel force before

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activation is greater than its peel force after activation due to the presence of the surface elements.

Regarding claim 2, Gochanour teaches activating the adhering side by applying hand pressure.

Regarding claim 3, Calhoun teaches the sheet material being repositionable after being applied to the target surface (column 9, lines 11-15) and Gochanour teaches the sheet material being easily removable after being activated (column 5, lines 3-8).

Regarding claim 4, Gochanour teaches at least a portion of the sheet material being impermeable to fluids through the utility side (column 4, lines 6 and 12-13).

Regarding claim 6, Gochanour teaches the sheet material being highly flexible such that it easily conforms to the target surface (Figure 2; column 4, lines 34-38).

Regarding claim 7, Gochanour teaches the utility side of the sheet material having a higher coefficient of friction than the target surface (column 4, lines 46-49) when contacting an object such as a tool or human skin (column 1, lines 10-11 and 60; column 2, lines 65-67).

Regarding claim 8, Gochanour teaches the utility side of the sheet material can be transparent (column 4, lines 38-39); therefore, since the target surface is a human hand (column 1, lines 5-8), the skilled artisan would have appreciated that the utility side would have an optical characteristic different from the target surface.

Regarding claim 9, Gochanour teaches providing the sheet material in roll form (column 6, lines 23-25).

Regarding claim 10, Gochanour teaches providing the sheet material in pre-cut discrete sheets (Figure 3; column 6, lines 18-19).

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Regarding claim 11, Gochanour teaches the sheet material being aseptic for providing infection protection (column 7, lines 42-44).

Regarding claim 12, Gochanour teaches the utility side of the sheet material bearing an antibacterial agent (column 4, lines 43-45).

Regarding claims 13-14, Gochanour teaches the sheet material being transparent to visible light (column 4, lines 38-39); note transparent and translucent are synonyms.

12. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gochanour and Calhoun et al. as applied to claim 1 above, and further in view of Hibler.

Regarding claim 18, it would have been obvious to provide printed indicia on the utility side of the sheet material of Gochanour because such is known in the art, as taught by Hilber (column 4, lines 30-34), and this allows for instructions to be present thereon.

13. Claims 1-3, 5-6, 8-10, 13-16, and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hibler in view of Calhoun.

With respect to claim 1, Hibler teaches a method for temporarily protecting or modifying a surface (abstract; column 1, lines 32-37). The reference teaches providing a sheet material having a base portion 12 (column 4, lines 1-15), a pressure-sensitive adhesive 44 on the backside of the base portion, and a utility side on the front side 16 of the base portion (Figures 1 and 3; column 4, lines 38-40). The reference teaches applying the adhering side to a target surface and activating the adhering side (column 4, lines 51-53).

The reference is silent as to non-elastically stretching the base portion, the adhering side of the sheet comprising surface elements, and the adhesive layer exposed through the surface

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elements such that after activation by a user, the adhering side exhibits an adhesion peel force greater than that exhibited before activation.

Applicants are directed to paragraph 9 above for a complete discussion of Calhoun. It would have been obvious to the skilled artisan at the time the invention was made to provide the exposed surface of the pressure-sensitive adhesive of Hibler with a plurality of surface elements, whereby non-elastically stretching the base portion of the sheet material in at least one dimension by a ratio of at least 1:1.05 results in separation of the surface elements located on the surface of the adhesive because such is known in the art, as taught by Calhoun, and this allows the sheet material to be correctly positioned on the target surface before activating the adhesive to bond the sheet material to the same (Calhoun; column 9, lines 11-15). The skilled artisan would have appreciated that the sheet material is repositionable because its peel force before activation is less than its peel force after activation due to the presence of the surface elements.

Regarding claim 2, Hibler teaches activating the adhering side by finger or hand pressure (column 4, lines 51-53).

Regarding claim 3, Calhoun teaches the sheet material being repositionable after being applied to the target surface (column 9, lines 11-15) and Hibler teaches the sheet material being easily removable after being activated (column 2, lines 37-42).

Regarding claim 5, Hibler teaches at least a portion of the sheet material being impermeable to fluids through the utility side (column 4, lines 4-8).

Regarding claim 6, Hibler teaches the sheet material being highly flexible such that it easily conforms to the target surface (column 3, lines 30-37).

Regarding claim 8, Hibler teaches the utility side can be any color or it can be transparent (column 4, lines 22-25); therefore, since Hibler teaches adhering the sheet to people, people's clothing, tables, etc. (column 3, lines 30-37), the skilled artisan would have appreciated that the utility side could have optical properties different from the target surface.

Regarding claim 9, Hibler teaches providing the sheet material in roll form (Figure 5; column 2, lines 57-58).

Regarding claim 10, Hibler teaches providing the sheet material in pre-cut discrete sheets (Figure 4; column 2, lines 55-56).

Regarding claims 13-14, Hibler teaches the sheet material being transparent to visible light (column 4, lines 23-24); note transparent and translucent are synonyms.

Regarding claims 15-16, Hibler teaches the sheet material can be partially impermeable to light of wavelengths in a specific range while also teaching the sheet material being opaque to visible light since the reference teaches the sheet being any color (column 4, lines 22-23).

Regarding claim 18, Hibler teaches providing printed indicia on the utility side (column 4, lines 19-22).

14. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hibler and Calhoun et al. as applied to claim 1 above, and further in view of Loewer et al. (US 6256788; provided in IDS).

Regarding claim 4, Hibler is silent as to at least a portion of the sheet material being absorbent to fluids. It would have been obvious to include such an absorbent material in the sheet of Hibler because it is known in the art to make pressure-sensitive adhesive-backed protective articles comprising a combination of fluid impermeable and fluid absorbent materials,

as taught by Loewer (Figures; abstract; column 3, lines 5-20), wherein the impermeable material prevents fluids from penetrating through the sheet material to the clothing of the wearer.

15. Claims 7 and 11-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hibler and Calhoun et al. as applied to claim 1 above, and further in view of Gochanour.

Regarding claim 7, it would have been obvious to the skilled artisan to use a utility side having a higher coefficient of friction than the target surface for that of Hibler because such is known in the art, as taught by Gochanour (column 4, lines 46-48), wherein this prevents objects from slipping; note Hibler teaches the sheet material also being used as a place mat, tablecloth, etc. (column 3, lines 35-37).

Regarding claims 11-12, it would have been obvious to the skilled artisan to have the utility side of Hibler be aseptic and/or bear an antibacterial agent because such is known in the art, as taught by Gochanour (column 4, lines 43-44; column 7, lines 42-44), wherein this prevents the buildup of germs that could infect the user.

16. Claims 1-3, 6, 8-10, and 15-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kaltman et al. in view of Calhoun et al.

With respect to claim 1, Kaltman teaches a method for temporarily protecting or modifying a surface (abstract). The reference teaches providing a sheet material having a base portion 2, a pressure-sensitive adhesive 5/18 on the backside of the base portion, and a utility side on the front side of the base portion (Figures 2b, 9; column 1, lines 18-27; column 2, lines 24-26 and 62-67). The reference teaches applying the adhering side to a target surface and activating the adhering side (Figure 11).

The reference is silent as to non-elastically stretching the base portion, the adhering side of the sheet comprising surface elements, and the adhesive layer exposed through the surface elements such that after activation by a user, the adhering side exhibits an adhesion peel force greater than that exhibited before activation.

Applicants are directed to paragraph 9 above for a complete discussion of Calhoun. It would have been obvious to the skilled artisan at the time the invention was made to provide the exposed surface of the pressure-sensitive adhesive of Kaltman with a plurality of surface elements, whereby non-elastically stretching the base portion of the sheet material in at least one dimension by a ratio of at least 1:1.05 results in separation of the surface elements located on the surface of the adhesive because such is known in the art, as taught by Calhoun, and this allows the sheet material to be correctly positioned on the target surface before activating the adhesive to bond the sheet material to the same (Calhoun; column 9, lines 11-15). The skilled artisan would have appreciated that the sheet material is repositionable because its peel force before activation is less than its peel force after activation due to the presence of the surface elements.

Regarding claim 2, Kaltman teaches activating the adhering side by finger or hand pressure (column 4, lines 51-53).

Regarding claim 3, Calhoun teaches the sheet material being repositionable after being applied to the target surface (column 9, lines 11-15) and Kaltman teaches the sheet material being easily removable after being activated (abstract).

Regarding claim 6, Kaltman teaches the sheet material being highly flexible such that it conforms to the target surface (Figure 11; column 1, lines 39-45).

Regarding claim 8, Kaltman teaches the sheet material having an optical characteristic different from the target surface (column 1, lines 19-20).

Regarding claims 9-10, Kaltman teaches providing the sheet material in roll or pre-cut sheet form (Figures 7 and 10; column 1, lines 46-48; column 2, lines 60-61).

Regarding claims 15-16, Kaltman teaches the sheet material being at least partially impermeable to light of wavelengths in a specific range while also teaching it being partially opaque to visible light (column 1, lines 17-20).

Regarding claim 17, Kaltman teaches the sheet material providing radiation protection (column 1, lines 19-20).

17. Claim 4, 7, and 11-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kaltman et al. and Calhoun et al. as applied to claim 1 above, and further in view of Gochanour.

Regarding claim 4, it would have been obvious to the skilled artisan to make the sheet material of Kaltman impermeable to fluids because such is known in the art, as taught by Gochanour (column 4, lines 12-13), wherein this prevents any fluids from penetrating through to the skin of the wearer.

Regarding claim 7, it would have been obvious to the skilled artisan to use a utility side having a higher coefficient of friction than the target surface for that of Kaltman because such is known in the art, as taught by Gochanour (column 4, lines 46-48), wherein this would make gripping the sheet material easy.

Regarding claims 11-12, it would have been obvious to the skilled artisan to have the utility side of Kaltman be aseptic and/or bear an antibacterial agent because such is known in the

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art, as taught by Gochanour (column 4, lines 43-44; column 7, lines 42-44), wherein this prevents the buildup of germs that could infect the user.

18. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kaltman et al. and Calhoun et al. as applied to claim 1 above, and further in view of Hibler.

Regarding claim 18, it would have been obvious to provide printed indicia on the utility side of the sheet material of Kaltman because such is known in the art, as taught by Hilber (column 4, lines 30-34), and this allows for instructions to be present thereon.

Double Patenting

19. Applicant is advised that should claim 13 be found allowable, claim 14 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof; **note that transparent and translucent are synonyms**. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

20. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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21. Claims 1-16 and 18 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-4, 6-16, 18-35, 37-50, and 52-58 of copending Application No. 10/016,544 in view of the collective teachings of Ochi, Merrill et al., Gochanour, and Hibler and also in view of Calhoun et al.

With respect to claim 1, claim 41 of the copending application teaches all the limitations except the method being for temporary surface protection or modification, the stretch ratio of the film, and the adhering side exhibiting a peel force greater than that exhibited before activation by a user.

It would have been obvious to apply the adhesive-backed film of the copending application to the substrate so as to temporarily protect or modify the same because such is known in the art, as taught by the collective teachings of Ochi, Merrill, Gochanour, and Hibler (see paragraph 9 above for complete discussion), wherein this allows for protection and/or modification of a surface of the substrate without having to manipulate the surface itself.

It would have been obvious to the skilled artisan at the time the invention was made to stretch the film of the copending application by a stretch ratio of at least 1:1.05 because such is known in the art, as taught by Calhoun (see paragraph 9 above for complete discussion), wherein this results in adequate separation between the spacer elements.

As for the peel force limitation, the skilled artisan would have appreciated that the film of the copending application, given the similarities between its structure and that of the present invention, would exhibit a peel force greater than that exhibited before activation by a user.

With respect to claim 1, claims 1-4, 10, 37-40, and 42-50 of the copending application teach all the limitations except the method being for temporary surface protection or

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modification, the stretch ratio of the film, the operating agent/intermediate surface/intermediate layer being adhesive, and the adhering side exhibiting a peel force greater than that exhibited before activation by a user.

It would have been obvious to the skilled artisan at the time the invention was made to have the operating agent/intermediate surface/intermediate layer be adhesive because such is known in the art, as taught by Calhoun, wherein this facilitates attachment of the film to the target surface.

Please refer to previous paragraphs for teachings of the other limitations and motivation to combine these teachings with the copending application.

With respect to claim 1, claim 8 of the copending application teaches all the limitations except the method being for temporary surface protection or modification, the stretching being inelastic, the stretch ratio of the film, and the adhering side exhibiting a peel force greater than that exhibited before activation by a user.

It would have been obvious to the skilled artisan to use a sheet material that can be inelastically stretched because such is known in the art, as taught by Calhoun, wherein this maintains the desired spacing between the elements.

Please refer to previous paragraphs for teachings of the other limitations and motivation to combine these teachings with the copending application.

With respect to claim 1, claims 6-7, 9, 11-16, 21-22, 25, 53, and 58 of the copending application teach all the limitations except the method being for temporary surface protection or modification, the stretching being inelastic, the stretch ratio of the film, the operating

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agent/intermediate surface/intermediate layer being adhesive, and the adhering side exhibiting a peel force greater than that exhibited before activation by a user.

Please refer to previous paragraphs for teachings of these limitations and motivation to combine these teachings with the copending application.

With respect to claim 1, claims 23-24 and 54 of the copending application teach all the limitations except the method being for temporary surface protection or modification, the stretching being inelastic, the stretch ratio of the film, the adhering side exhibiting a peel force greater than that exhibited before activation by a user, applying the adhering side on a target surface, and activating the adhering side.

It would have been obvious to the skilled artisan at the time the invention was made to apply the adhering side on a target surface and activate the adhering side in order to temporarily protect or modify the target surface because such is known in the art, as taught by the collective teachings of Ochi, Merrill, Gochanour, and Hibler wherein this eliminates the need to manipulate the surface itself.

Please refer to previous paragraphs for teachings of the other limitations and motivation to combine these teachings with the copending application.

With respect to claim 1, claim 35 of the copending application teaches all the limitations except the method being for temporary surface protection or modification, the stretching being inelastic, the stretch ratio of the film, the intermediate surface being adhesive, the adhering side exhibiting a peel force greater than that exhibited before activation by a user, applying the adhering side on a target surface, and activating the adhering side.

Please refer to previous paragraphs for teachings of these limitations and motivation to combine these teachings with the copending application.

Regarding claim 2, claim 25 of the copending application teaches all the limitations except the method being for temporary surface protection or modification, the stretching being inelastic, the stretch ratio of the film, the operating agent/intermediate surface/intermediate layer being adhesive, and the adhering side exhibiting a peel force greater than that exhibited before activation by a user.

Please refer to previous paragraphs for teachings of these limitations and motivation to combine these teachings with the copending application.

Regarding claims 2-5, 6-16, and 18, please refer to paragraph 9 above for teachings of these limitations.

This is a provisional obviousness-type double patenting rejection.

22. Claim 17 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-4, 6-16, 18-35, 37-50, and 52-58 of copending Application No. 10/016,544 in view of the collective teachings of Ochi, Merrill et al., Gochanour, and Hibler and also in view of Calhoun et al., and further in view of Kaltman et al.

Regarding claim 17, it would have been obvious to the skilled artisan to have the sheet material of the copending application be adapted to provide radiation protection because such a pressure-sensitive adhesive-backed sheet material is known in the art, as taught by Kaltman (abstract; column 1, lines 19-27), wherein this imparts a characteristic to the sheet material that makes it very attractive to consumers.

This is a provisional obviousness-type double patenting rejection.

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Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Jessica L. Rossi** whose telephone number is **571-272-1223**. The examiner can normally be reached on M-F (8:00-5:30) First Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard D. Crispino can be reached on 571-272-1226. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Jessica L. Rossi

Jessica L. Rossi
Patent Examiner
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